

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed December 7, 2006. At the time of the Office Action, Claims 1-24 and 26-52 were pending in this Application. Claims 1-11, 13-21 and 27-50 were previously withdrawn due to an election/restriction requirement. Claims 12, 22-24, 26, 51 and 52 were rejected. Claim 25 was previously cancelled without prejudice or disclaimer. Applicants respectfully request reconsideration and favorable action in light of the comments below.

Rejections under 35 U.S.C. §103

Claims 12, 22, 23, 51 and 52.

Claims 12, 22, 23, 51 and 52 were rejected under 35 U.S.C. §103(a) as being anticipated over U.S. Patent No. 5,507,743 issued to Edwards et al. (“Edwards”) in view of U.S. Patent No. 5,873,877 issued to McGaffigan et al. (“McGaffigan”). Applicants respectfully traverse and submit the cited art combinations, even if proper, which Applicants do not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Independent Claims 12 and 51 each recite a method including, among other limitations, “positioning the active electrode in at least close proximity to the target tissue and an electrically conductive fluid, the active electrode located at a distal end of an elongate member extending through said coil such that said active electrode is positioned distal to said coil...” and positioning a distal section that includes, “an active electrode positioned on an elongate member extending through said coil and said active electrode being distal to said coil”, respectively. Emphasis added. The Edwards reference provides an active electrode that is coextensive with the coiled return electrode and does not disclose, teach or suggest providing an active electrode that is distal to the return electrode. See Figures 1A and 5. McGaffigan teaches the provision of first and second needle electrode assemblies which are both provided at the distal end of the device. See Figure 1. Accordingly, neither Edwards nor McGaffigan or a combination thereof

teaches providing an active electrode extending from an elongate member extending through the coils of the return electrode such that the active electrode is distal to the return electrode, as claimed. Applicants respectfully request reconsideration, withdrawal of the rejections under §103 and full allowance of Claims 12 and 51 and Claims 22, 23 and 52.

Claims 24 and 26.

Claim 24 was rejected under 35 U.S.C. §103(a) as being unpatentable over Edwards and McGaffigan in view of U.S. Patent No. 5,715,817 issued to Stevens-Wright et al. (“Stevens-Wright”). Claim 26 was rejected under 35 U.S.C. §103(a) as being unpatentable over Edwards, McGaffigan and Stevens-Wright and further in view of U.S. Patent No. 5,348,554 issued to Imran et al. (“Imran”). Applicants traverse and submit that Claims 24 and 26 depend from claims that are in condition for allowance and request reconsideration and favorable action.

Double Patenting Rejection

The Examiner rejected Claims 12, 22-24, 26, 51 and 52 based on the judicially created double patenting doctrine over Claims 1-124 of U.S. Patent No. 6,837,888 issued to Ciarrocca et al. (“888 patent”) stating that the subject matter claimed in the instant application is fully disclosed in the referenced patent.

The Examiner provisionally rejected Claims 12, 22-24, 26, 51 and 52 based on the judicially created double patenting doctrine over the pending claims of co-pending Application 10/072,599 by Dahla et al. (“599 application”) stating that the subject matter claimed in the instant application is fully disclosed in the referenced co-pending application and would be covered by any patent granted on that co-pending application since the referenced co-pending application and the instant application are claiming common subject matter.

Applicants respectfully traverse these rejections. However, to reduce the cost and time required to obtain patent protection, Two Terminal Disclaimers filed in compliance with 37 C.F.R. 1.321 are attached hereto. The Terminal Disclaimers are offered in the event the Examiner converts the provisional rejection to a rejection based on non-statutory double

patenting grounds. The '888 patent and '599 application and the instant patent application are commonly owned by ArthroCare Corporation.

Information Disclosure Statement

Applicants enclose an Information Disclosure Statement and PTO Form 1449, for the Examiner's review and consideration.

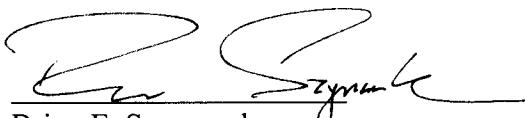
CONCLUSION

Applicants have made an earnest effort to place this case in condition for allowance in light of the amendments and remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants hereby authorized the Commissioner to charge \$180 for the IDS, and \$260 for the Terminal Disclaimers to Deposit Account No. 50-0359 of ArthroCare Corporation. Applicants believe there are no further fees due at this time, however, the Commissioner is hereby authorized to charge any additional fees necessary or credit any overpayment to Deposit Account No. 50-0359 of ArthroCare Corporation in order to effectuate this filing.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.391.3961.

Respectfully submitted
Attorney for Applicants,



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Date: 3-7-2007

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Enclosure: 1) An Information Disclosure Statement and PTO Form 1449.
2) Two Terminal Disclaimers.